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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/633,128 | 08/01/2003 | Steven Orville Stocker | 10991775-5 | 3085 |

7590 09/08/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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| EXAMINER |
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SAFAIPOUR, HOUSHANG

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| ART UNIT | PAPER NUMBER |
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2625

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,128

Applicant(s)

STOCKER, STEVEN ORVILLE

Examiner

Houshang Safaipoor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/01/03.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,667,817. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application is a broader recitation of claim 1 of the patent. Claim 1 of the instant application recites all limitations of claim 1 of the patent, as listed below, except the underlined portions:

A scanner for scanning an object in a scan direction, comprising:

first and second light monitor elements that are offset in the scan direction; and

a scanning system including:

a sensor,

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a light source adapted to direct light onto the object and onto the first and second light monitor elements such that light is reflected from the object and first and second light monitor elements; and

a light redirection system operable in a first mode to focus light reflected from the object and the first light monitor element onto the sensor and operable in a second mode to focus light reflected from the object and the second light monitor element onto the sensor, wherein the scanning system sequentially scans linear portions of the object that define scan lines and the scan lines in the first scanning mode are longer than the scan lines in the second scanning mode.

Claims 2-6, 8, 9 and 11-13 are rejected because they are anticipated by claims 2-6, 7, 8 and 9-11 of the patent respectively.

Claim 7 is rejected because it is anticipated by claim 1 of the patent (please refer to the first four lines of claim 1 of the patent).

Claim 10 is rejected because it is anticipated by claim 1 of the patent (please refer to the last limitation of claim 1 of the patent).

Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,667,817. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 14 of the instant application is a broader recitation of claim 12 of the patent. Claim 14 of the instant application recites all limitations of claim 12 of the patent, as listed below, except the underlined portions:

A scanner for scanning an object in a scan direction, comprising:

A housing including a window;

first and second light monitor elements associated with the window and offset from one another in the scan direction; and

a scanning system including a sensor with a sensing area, the scanning system being operable in a first mode to focus a region of the object and the first light monitor element onto the sensor and operable in a second mode to focus a region of the object and the second light monitor element onto the sensor, the region scanned in the first mode being longer than the region scanned in the second mode and the regions occupying the same length of the sensor sensing area in the first and second modes.

Claim 15 is rejected because it is anticipated by claim 13 of the patent.

Claim 17 is rejected because it is anticipated by claim 18 of the patent (please refer to the last limitation of claim 18 of the patent).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 16 is dependent upon independent claim 14 and is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of the prior U.S. Patent No. 6,667,817. All of the limitations recited in claim 16 (which includes limitations of claim 14 because of the

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dependency) are anticipated by claim 12 of the patent. The only exception is the tense (form of verb) used in the application which is different from the tense used in the patent (example: "is" versus "being" and "occupy" versus "occupying"). This is a double patenting rejection.

Claims 18-21 are anticipated (identical) by claims 14-17 of the prior U.S. Patent No. 6,667,817 (please refer to col. 8, lines 12-33) and therefore are rejected under 35 U.S.C. 101 as claiming the same invention. This is a double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Houshang Safaipoor
Patent Examiner
Art Unit 2625
August 31, 2006

H-49/8/1
9/1/06